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DOUGLAS S. FOOTE			EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL C. BLANK and MARK E. KEETON

Appeal 2008-4190
Application 10/804,953
Technology Center 1700

Decided: August 29, 2008

Before CATHERINE Q. TIMM, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This is an appeal from the final rejection of claims 1-29 and 31.

Our review of the application leads us to conclude that this appeal includes a record that is not ripe for review. Therefore, pursuant to 37 C.F.R. § 41.50(a), we remand this application to the Examiner to consider the following issues and take appropriate action consistent with our comments below. 37 C.F.R. §§ 41.35(b) and 41.50(a)(1) (2006).

The Final Rejection includes a rejection of claim 26 over the combined teaching of Smith, Slagsvol, and Lane (Final Rejection p. 9). The Appeal Brief filed March 19, 2007 states that the rejection of claim 26 is to be reviewed on appeal (Br. 9). However, the Examiner's Answer does not contain a rejection of claim 26, even though it states the Appellants' statement of the grounds to be reviewed on appeal is correct (Ans. 2). Thus, the Examiner's Answer is internally inconsistent as well as inconsistent with the file record as reflected by the Final Rejection. We decline to speculate as to the status of claim 26.

In addition, we note that the Examiner addresses several points in the Answer that are not applicable to this record. For example, the Examiner discusses whether Michel is analogous art (Ans. 11). Michel is not a reference relied upon in any of the rejections made in the Final Rejection or in the Examiner's Answer. The Examiner also presents a full page of remarks regarding "claims 1 and 19 which expressly recite different length adhesive free zones in each label"; however, neither claim 1 nor claim 19 nor any claim in this case contains such a limitation (Ans. 12). We note that claim 1 of copending application Serial No. 11/013,561 (which is currently on appeal; Appeal No. 2008-3819)¹ recites such a limitation.

Furthermore, the Examiner has not addressed Appellants' arguments regarding claims 10 and 16 (Ans. 24; Br. 42-47). Specifically, the Examiner discusses limitations which are not in claim 10 (namely, cooperation between the registration marks and the adhesive free zones)

¹ The Appeal Brief filed May 10, 2007 in Appeal No. 2008-3819 indicates on page 3 thereof that the application of that appeal "discloses an improvement over application No. 10/804,953," the application involved in this appeal.

and does not discuss the limitation that is in claim 10 (namely, that the web is devoid of index marks) (see, Ans. 24). The Examiner should consider that Smith explicitly teaches that while registration marks 19 (i.e., index marks) are desirable, they are not necessary (Smith, col. 3, ll. 19-27). With regard to claim 16, the Examiner fails to discuss the reference relied upon, namely, Lane (see, Ans. 24).

The Examiner should also consider whether Lane should be relied upon in all of the rejections of the claims on appeal (e.g., as a teaching reference). Lane is only applied to dependent claims 10 and 16 in the Examiner's Answer. However, Lane teaches that it is desirable for there to be "ungummed margins" (compare to "adhesive-free spaces" as recited in each of the independent claims 1, 19, and 31) in between the "gummed areas 11" (e.g., "adhesive patches" as recited in each of claims 1, 19, and 31) and the edges of each label (as, e.g., defined by perforations 12) so that cutting can occur without fouling or gumming of the cutting knife (see, e.g., Lane, p. 3, col. 1., ll. 11-44). The Examiner should consider that this teaching appears to be particularly pertinent to all the claims, since each of the independent claims 1, 19, and 31 recites that the function of the adhesive-free spaces is to permit cutting of said web in adhesive-free spaces.

Based on the foregoing, we determine that the present record is not yet ripe for our review. The inconsistencies in the record require resolution prior to our rendering a decision on this appeal.

Therefore, we remand the application to the Examiner to set forth a clear statement of the grounds of rejection which are to be reviewed and to

provide or restate responsive arguments to Appellants' positions as set forth in the Brief.

Furthermore, any Answer submitted by the Examiner should be self-contained with respect to all rejections and arguments; no prior Answer or Office action should be referenced or incorporated therein. Any additional Brief submitted by Appellants should be self-contained with respect to all arguments. No prior Briefs should be referenced or incorporated therein.

CONCLUSION

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board.

37 C.F.R. § 41.50(a)(2) states:

2) If a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) *Reopen prosecution.* Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be

reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(ii) *Maintain appeal*. Request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REMAND

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